

Remarks

Thank you for your continued work in connection with this Application and for conducting the interview on July 26, 2007. An interview summary is provided at the end of the remarks.

Amendments

The specification and claims are amended as noted. Text additions are underlined and text deletions are indicated by strike out marks or double brackets.

The specification is amended at pages 4 and 13 to correct a spelling error. The specification is further amended for complete consistency between the ordering of the sleeve panels in the text and claims (i.e., to identify the sleeve first, second and third panels). The sleeve panels 47, 49, 51 of the exemplary sleeve 11 continue to remain associated, respectively, with the corresponding binder clip spine 15 and jaw portions 17, 19 so no new matter is added by these clarifying, non-substantive amendments.

Independent claim 23 is amended so that the sleeve panel order is consistent with the other independent claims and text as noted above. The word engagement is deleted from claim 23 in view of the securement recited elsewhere in the claim and the overlying relationship of the panels to the binder clip is adjusted consistent therewith. Claim 33 is amended to correct a misspelling of polyethylene.

Independent claims 1, 15, 23, and 27 are amended to more specifically describe the invention as the combination of a binder clip and tri-panel sleeve and to more specifically describe the binder clip structure, particularly the tips which are resiliently biased to abut and which can be separated or opened by pushing on the handles. The binder clip as defined is unlike a stencil indicator. Support for the amendments is found in the Application, for example, at page 1, lines 10-27, page 4, lines 5-10, page 6, line 23 through page 7, line 15, and Figures 1, 2,3,5, and 10. As is apparent from the citations, no new matter is added.

Rejections under 35 U.S.C. § 103(a)

Claims 1-12, 14, 15, and 17-33 were rejected under 35 U.S.C § 103(a) based on U.S. Patent No. 1,232,747 (Yochim) in view of Smead Viewables and U.S. Patent No. 5,806,147 (Sato). Reconsideration and withdrawal of all rejections is requested in view of the following remarks.

The Office takes that position that the Yochim stencil indicator is a binder clip. At page 2 of the Office Action it is stated that “Yochim discloses a tri-panel binder clip” At page 5 of the Office Action, the following statement is made:

Further Applicant alleges that “Yochim’s bent sheet metal part is not a ‘binder clip’ as claimed.” But Yochim states that the “inherent resiliency of the sides 3 and 4 of the sheet 2 serve to grippingly engage a stencil or the like when inserted therebetween” (page 1, lines 69-75). Thus it is clear that Yochim discloses a binder clip, a binder clip which differs from Applicant’s claimed binder clip only in that it lacks handles secured to its jaw portions, a deficiency that is acknowledged in the rejection, above, and that is supplied by Sato, which clearly teaches the desirability of attaching handles to resilient jaw portions of a binder clip, in order to make it easier to separate the jaw portions.

Respectfully, the Yochim Stencil indicator is not a binder clip and cannot be modified to be a binder clip. Please see the accompanying 37 C.F.R. § 1.132 Declaration of James Marschalek at ¶¶ 28 and 29. The Yochim stencil indicator cannot be modified to be a binder clip because to do so would render Yochim unsuitable for its purpose. *Id.* A Yochim stencil indicator is not a binder clip and a binder clip is not a stencil indicator as envisioned by Yochim. *Id.* at ¶ 29. Yochim cannot be likened to a binder clip because the Yochim stencil indicator structure requires that there be a gap between the tips of the device to receive the stencil or paper file without damage to the stencil or paper file, thereby preventing and/or interfering with the ability of the Yochim’s stencil indicator to grip a full range of articles as required of a binder clip. *Id.* at ¶¶ 3, 7, 9-20 and 27. The conclusion which necessarily follows from this evidence is that Yochim teaches away from Applicant’s invention – a person of skill in the art would not

look to Yochim as a binder clip as claimed and could not modify Yochim to be a binder clip without defeating the purpose of Yochim's stencil indicator. Id. at ¶ 29.

The Examiner is requested to review the entirety of the evidence presented in Mr. Marshalek's declaration. In summary, Mr. Marschalek is a person of skill in the mechanical arts with experience performing finite element analysis of structures (also referred to as "FEA"). Id. at ¶¶ 1-2. Mr. Marshalek performed a finite element analysis of two embodiments of the Yochim stencil indicator, with each embodiment being identical except for the thickness of the material used to make the stencil indicator. Id. at ¶¶ 3-7. The first model included a material thickness of 0.054 inches (Marschalek Exhibit A) based on the ratios provided in the Yochim patent and the second model included a material thickness of 0.020 inches (Marschalek Exhibits B and C) based on the material thickness of a conventional binder clip. Id. at ¶¶ 5 and 6.

What the FEA demonstrated is that the material properties of the Yochim stencil indicator are such that a gap is necessary and required between the tips of the Yochim stencil indicator. Id. at ¶¶ 7 and 18-19. The gap is required because the Yochim stencil indicator is a stiff structure which deforms very little when opened. Id. at ¶¶ 11-16 and Exhibits B and C. To open the Yochim stencil indicator an additional 0.100 inches, a user would have to supply a force of 77 pounds (38.5×2) for the 0.054 inch thick Yochim stencil indicator while a force of 3.16 pounds (1.58×2) would be required for the 0.020 inch thick Yochim stencil indicator. Id. at ¶¶ 15-16 and 22. Multiplication by two is required because the force modeled in the analysis is applied to each side of the stencil indicator.

If there were no gap between the tips of the Yochim stencil indicator then that device would have to be slid onto the stencil or paper file without first spreading the tips. Id. at ¶¶ 18-19. This would result in damage to the stencil or to the paper file as the sharp metal edges of the stencil indicator would be pushed onto the stencil or paper file. Id. at ¶¶ 18. To illustrate this problem, the Examiner is asked to attempt to fit a conventional binder clip over a stack of papers without using the handles. Id. It is apparent that doing this will damage the papers unless the

tips are first separated in some way. Id.

Important problems flow from the requirement of a gap between the tips of the Yochim stencil indicator which render such a Yochim stencil indicator unacceptable for use as a binder clip. Id. at ¶ 20. These deficiencies include:

- An inability to grip objects narrower than the gap. Id. at ¶ 21.
- A general inability to open the tips of the 0.054 inch thick stencil indicator because of the high force required. Id. at ¶ 17.
- An inability to firmly grip objects slightly wider than the gap of the 0.020 inch thick stencil indicator because insufficient force is exerted. Id. at ¶ 22. This would cause papers to fall out, for example.
- An inability to provide a preload force which would urge the tips tightly into contact with each other to tightly grip objects as is the case with conventional binder clips which do not include a gap between the tips. Id. at ¶¶ 18 and 23. Absence of a preload force because of the gap would also cause papers to fall out.

Other deficiencies rendering the Yochim stencil indicator unacceptable for use as a binder clip include:

- An excessive weight of 1.38 or 0.51 pounds respectively for the 0.054 inch and 0.020 thick stencil indicators. This excessive weight would bend paper or paper files unless those papers or files were extremely stout. Id. at ¶¶ 8, 24.
- An inability to open the tips because no handles are contemplated. Id. at ¶ 25. As stated, this can result in damage to any stencil or paper file wider than the gap. Id.

It is important to note that the conclusions reached by Mr. Marschalek do not depend on the size of the Yochim stencil indicator or the gap that it requires. Id. at ¶ 26. In particular, the gap size is not what is important; what is important is that a gap be present for the Yochim stencil indicator to behave as intended. Id.

Mr. Marschalek concludes with the following three paragraphs reproduced in full:

27. To be effective as a binder clip, the clip must do at least two things. First, it must be able to hold together a full range of objects, including small quantities of thin articles, such as paper sheets. Second, it must hold these objects together securely so the articles do not fall out of the clip. The binder clip should not tear, crease, bend or otherwise damage the article or thing being gripped when the clip is attached to or removed from such articles or things.

28. Based on the foregoing, I conclude that the Yochim product may function adequately as a stencil indicator but would not function adequately as a binder clip. Yochim cannot fairly be likened to a binder clip because Yochim would not be effective for holding together small groups of articles, such as papers.

29. Given the structural and operational differences between the Yochim stencil indicator and a conventional binder clip and the contradictory or inconsistent purposes of these products, I believe that a person of ordinary skill in the mechanical arts would find it difficult and challenging to combine these products. As already noted, the Yochim stencil indicator must be designed to avoid the gripping that is required for proper operation of a binder clip. Therefore, it cannot be said that Yochim could be converted to a binder clip simply by bending Yochim differently or using a different material to make Yochim. If this was done, the resultant product would not be suitable for use as a stencil indicator as envisioned in the Yochim patent. And, it cannot be said that a binder clip could simply be bent differently to provide a gap between the jaws because to do so would prevent the binder clip from gripping thin articles. In short, a Yochim stencil indicator is not a binder clip and a binder clip is not a stencil indicator as envisioned by Yochim. I do not believe that a person of skill in the mechanical arts would look to the teaching of Yochim as a teaching of a binder clip.

Mr. Marschalek therefore refutes the Office's position that Yochim is a binder clip. Yochim is not a binder clip and cannot be modified to be a binder clip. This is not a simple matter of adding handles to Yochim as has been done in the Office Action quoted above. It would be impossible for a person of skill in the art to modify Yochim to be a binder clip without destroying the fundamental purpose of Yochim.

What is utterly missing from the prior art of record is any recognition that a conventional binder clip can be improved by associating information with that binder clip. Neither Yochim, Sato, nor Smead Viewables separately or in combination teach or suggest any such recognition. Yochim is not a binder clip and lacks any tri-panel sleeve with indicia, Sato never envisioned any binder clip sleeve and Smead Viewables requires a tab support dedicated for use with a Smead hanging file folder.

It is Applicant alone who has recognized the utility in the combination of a binder clip and sleeve as claimed. After a detailed BACKGROUND OF THE INVENTION Section in which binder clips are acknowledged and a survey of other products is presented, Applicant recognizes that:

It would be a significant improvement in the art to provide a binder clip sleeve which would serve to optimize the utility of binder clips, which would permit use of the binder clip as a productivity tool and communication platform without interfering with handling of documents and things gripped by the binder clip, which would present an opportunity to make the binder clip more aesthetically pleasing and which would be simple and economical to manufacture and use. Application at page 3, lines 2-7.

In fulfillment of the aforementioned recognition, Applicant teaches the following unobvious improvements made possible by Applicant's invention, namely that:

- "The inventive sleeve advantageously permits a near limitless range of graphic and text indicia to be quickly and easily associated with the binder clip." Application at page 3, lines 17-18.
- "The indicia-bearing clip has significant utility across a broad range of productivity-enhancement and communication applications. Such applications include use of the binder clip as an advertising platform" *Id.* at page 3, lines 20-23 (emphasis added), and
- "The sleeve advantageously provides increased area for location of indicia and permits improved viewing of the indicia from plural sides of the clipped documents.

... The inventive sleeve is adapted for use with commercially-available, unmodified binder clips and is rugged and simple to manufacture.” *Id.* at page 3, line 29 through page 4, line 3.

No art cited by the Office touches on any of these important advantages recognized by the Applicant. That is true from prior to the 1917 date of Yochim to and including the present. As was stated in the January 23, 2007 Amendment, “The fact that the elements of Applicant’s claimed binder clip sleeve lay about in the prior art available for years to all skilled workers without suggesting anything like the claimed invention is itself evidence of non-obviousness. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1577 (Fed. Cir. 1987). Recognition of a problem to be solved is invention; there is no proof in the record that anyone recognized the solution proposed in the Application.

New Evidence of Secondary Considerations

Accompanying this paper is the Supplemental Declaration of Richard Raddatz submitted pursuant to 37 C.F.R. § 1.132. This declaration supplements Mr. Raddatz’ September 25, 2006 declaration submitted with the January 23, 2007 Amendment and provides new objective evidence demonstrating the value and non-obviousness of the claimed product, particularly in the context of use as an advertising tool.

As was stated in the January 23, 2007 Amendment, objective evidence of non-obviousness can be used to rebut a *prima facie* case of obviousness based on prior art references. *Tec Air, Inc. v. Denso Mfg. Mach. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999); MPEP § 2141(III.) at 2100-125 (“Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence.”)

Mr. Raddatz provides new evidence establishing that he has marketed, manufactured, and sold over 22,000 Custom Clips products. Raddatz declaration at ¶ 3. Mr. Raddatz' marketing efforts have included direct mail, telemarketing, Internet advertising, sales calls, and trade show booths. Id. Mr. Raddatz believes that this represents 100% of the market share for Custom Clip products because he is not aware of any other product being marketed which marries a binder clip and a binder clip sleeve to provide a specialty advertising product as shown and described in his previous declaration. Id.

Mr. Raddatz further provides new evidence describing specialty advertising trade shows that he has attended for the purpose of promoting sale of the Custom Clip product. Raddatz declaration at ¶ 4. Mr. Raddatz states that thousands of trade show participants have visited his booth at these shows and have seen the Custom Clip on display. Id. No person ever indicated to Mr. Raddatz during the shows that he or she had previously seen a specialty advertising product like, or similar to, the Custom Clip. Id. What Mr. Raddatz did hear from the people who stopped at his booth was comments to the effect of, "I wish I would have thought of that product." Id. Mr. Raddatz was told by people who stopped at his booth that the Custom Clip product was going to be a very successful specialty advertising product. Id.

Additional new evidence provided by Mr. Raddatz is that over twelve vendors of specialty advertising products have agreed to add Custom Clips to their product line. Raddatz declaration at ¶ 5. Mr. Raddatz identifies eight of these vendors by name and states that these eight vendors are ranked in the top 40 vendors compiled by the Advertising Specialty Institute. Id. Mr. Raddatz identifies two additional vendors by name as major vendors. Id.

Mr. Raddatz states that major vendors of the specialty advertising industry review many new specialty advertising items each year. Id. These vendors would not add Custom Clips to their product line unless the product was unique and going to sell. Id. Each vendor is represented by independent sales representatives and in-house sales representatives. Id. As a result, the Custom Clips product will gain exposure throughout the United States. Id. It is Mr.

Raddatz' belief and expectation that sales of Custom Clips will increase 1,000-fold as customers of the specialty advertising product vendors (such as the vendors mentioned above) become aware of the Custom Clip product. This, in turn, will mean increased sales of the Custom Clip for Mr. Raddatz' company.

Mr. Raddatz states that the "buzz" and interest that is being generated with respect to the Custom Clip product as described in his two declarations and the actual sales information provided in the declarations demonstrates that there is a long felt need for this product and that the product is and will be a commercial success. Id. at ¶ 6. Mr. Raddatz expects that the Custom Clip product will achieve great marketplace success as the product matures in its product cycle. Id.

Internet downloads showing active marketing of the product as of today (September 27, 2007) are provided with this Amendment. Declaration of John E. Munger. These marketing materials were downloaded from the Internet site <http://www.customclips.biz>. The Office is invited to visit this site to see the information first hand.

What this new evidence shows is that the still immature Custom Clip product is being marketed actively, is generating substantial sales, and is gaining recognition as an exciting new product with significant market potential going forward. All of this new evidence further reinforces the Raddatz, Jolly, and Fries declarations submitted January 23, 2007 to the effect that the Custom Clip, as claimed, is and will be a commercial success and that this product satisfies a long felt need within the specialty advertising industry.

Prior Evidence of Secondary Considerations

The Raddatz, Jolly and Fries declarations previously submitted on January 23, 2007 provided objective evidence of secondary considerations supporting Applicant's contention that the claimed invention is not obvious. However, it was said in the Office Action that the declarants' opinions on the ultimate issues in the case were not evidence and that all three experts were said to be interested in the case. Office Action at page 4, ¶ 6. Reconsideration is requested.

As to the first point, all three men provided facts upon which their conclusions were based. All three declarants stated facts demonstrating their years of experience in the specialty advertising market and knowledge of the types of products available in the specialty marketing industry. All three declarants stated that they had never previously seen a product like the Custom Clip in their many years of business. The uniqueness of the product was attributed to the combination of the tri-panel sleeve and binder clip which permitted a binder clip to be useful in presenting advertising and other information. These are facts which support the conclusion that the claimed subject matter is not obvious.

As to the second point, it is actually contrary to the self interest of Messrs. Jolly and Fries to support Applicant's view that the invention is non-obvious. This is because both Messrs. Jolly and Fries sell specialty advertising products. Jolly declaration at ¶¶ 2-3; Fries declaration at ¶ 2. Both men would benefit if a patent were not issued because they could obtain the "Custom Clip" product through a source other than Applicant or Applicant's licensee.

Mr. Raddatz' two declarations should be given significant weight because they present a cogent fact-based analysis supporting Mr. Raddatz' conclusion that the Custom Clip product is unique and non-obvious. The Raddatz declarations provide objective evidence of the commercial interest and "buzz" that is being generated by the Custom Clip product. This is fact-based information which must be duly considered, particularly given the deficiencies in the teachings of the applied references.

Mr. Raddatz further provides objective evidence that an exclusive license exists for the claimed subject matter. As stated in the January 23, 2007 Amendment, the existence of a license agreement is objective evidence that the invention is not obvious by showing commercial success, long-felt need and copying by others. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F. 2d 1530, 1539 (Fed. Cir. 1983); *B & H Manufacturing Inc. v. Foster-Forbes Glass Co.*, 26 U.S.P.Q.2d 1066, 1070 (N.D. Ind. 1993). Whatever self-interest Mr. Raddatz may allegedly have, this is a matter of weight and not admissibility of his declaration testimony.

All of this objective evidence demonstrates that the invention is not obvious and, under the law, this evidence must be considered and not disregarded in a conclusory manner.

Interview Summary

On July 26, 2007 a telephonic interview was conducted with respect to this Application. Present for the interview were Examiner Gary C. Hoge and John E. Munger, attorney for Applicant. U.S. Patent Nos. 1,232,747 (Yochim), and 5,806,147 (Sato), and Smead Viewables were discussed. Applicant's January 23, 2007 Amendment and the declarations of Richard Raddatz, Lyle Fries and Ed Jolly provided with the Amendment were also discussed. Independent claims 1, 15, 23, and 27 were discussed. No agreement was reached.

An interview summary form was sent by Mr. Hoge on August 7, 2007. The form is generally factually correct but supplementation would be useful. During the interview Mr. Munger said that the rejection of Applicant's claims based on Yochim, Sato, and Smead Viewables was incorrect. Mr. Munger said that Yochim was not a binder clip and did not teach or suggest Applicant's invention. As per the interview summary form, Mr. Munger suggested that Yochim would deform when opened because of the long length, thereby showing that the Yochim stencil indicator was not a binder clip. Mr. Hoge did mention that this was speculative.

Mr. Marschlek's FEA was undertaken to remove the speculation. What is now known from the FEA is that the Yochim stencil indicator is, in fact, stiff but is otherwise not capable of use as a binder clip due to the required gap and other deficiencies as described in this Amendment. Independent claims 1, 15, 23, and 27 have been amended to better define the structure of a binder clip thereby further distancing Applicant's invention from Yochim's stencil indicator.

With regard to Smead Viewables, Mr. Munger stated that the teaching of Smead Viewables was very narrow and was limited to a file folder system in which a label is applied to a tab which is attached to a Smead file folder. It was pointed out that Smead Viewables has nothing whatsoever to do with binder clips. Sato was discussed as being limited to binder clips which have been conceded as old in the art.

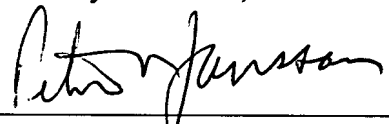
Applicant's evidence of secondary consideration was also discussed. Mr. Munger stated that the evidence of secondary considerations was not given the required consideration. Mr. Munger said that the Jolly, Fries, and Raddatz declarations were fact based and provided evidence that persons of skill in the art believed the claimed subject matter to have great merit, even though the Custom Clip product was early in its marketing cycle. The secondary evidence also showed the existence of a license agreement which is further evidence of the non-obviousness of the invention. Mr. Hoge said that he did not view the secondary evidence as persuasive because of the prior art cited. It is respectfully requested that Mr. Hoge reconsider this position in view of the evidence submitted with this Amendment and the deficiencies and shortcomings of the applied art.

Request for Interview

In view of the above, reconsideration and allowance of this Application are now believed to be in order, and such actions are hereby solicited. The Examiner is kindly **requested to call** the undersigned at the telephone number listed below before issuing a further Office Action so that an interview can be conducted should any issues remain outstanding.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, is to be charged to Deposit Account No. 10-0270. Kindly notify the undersigned in the event that the deposit account is debited or credited.

Respectfully submitted,

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Chris Wipper
Name

Chris Wipper 9/27/07
Signature Date